

Section II (Remarks)

Amendments to the Claims

By the present Amendment, claims 1, 2, 16, and 17 have been amended. Claims 7 and 9 were previously cancelled. Claims 5, 6, 8, 16, 17, and 25-34 are withdrawn. No new matter within the meaning of 35 U.S.C. §132(a) has been introduced by the foregoing amendments.

The amendments made herein are fully consistent with and supported by the originally-filed disclosure of this application. Specifically, the amendments to claims 1 and 2 are supported in the specification at paragraph [0036] of the published patent application, in the examples set out at pages 10 – 20 in the description of the various embodiments of the invention, and in Figures 3–17.

Withdrawn claims 16 and 17 have been amended herein to depend from claim 1, having previously been dependent from cancelled claim 9.¹ Joinder of such withdrawn, currently amended claims with the pending elected claims 1-4, 10-15 and 18-24 is therefore requested.

Response to Rejection under 35 U.S.C. § 102

In the Office Action mailed April 9, 2008, the examiner has maintained the rejection of claims 1-4, 10-15, and 18-24 as anticipated by Syndbad (U.S. Patent No. 2,756,790). Specifically, the Office Action states that “Syndbad’s teaching reads on claims 1 and 2,” because “the Applicant does not claim the blade guard being on the dull edge of the blade,” and that the blade guard taught by Syndbad is “capable of being pivotably attached to the dull edge of the blade.” (Office Action mailed April 9, 2008, pg. 3, ll. 20-23, pg. 4, ll. 1-3) The Applicant traverses such rejection in light of the amendments made herein in independent claims 1 and 2, from which all remaining claims 3-4, 10-15 and 18-24 under consideration are variously dependent.

¹ The status of claims 16 and 17 is withdrawn and not cancelled. In applicant’s response to the October 11, 2007 Office Action, the claim listing inadvertently indicated the claim identifier “cancelled” instead of “withdrawn” for claims 16 and 17. The response to the October 11, 2007 Office Action directed cancellation of only claims 7 and 9. Claims 16 and 17, previously withdrawn from examination pursuant to a restriction requirement, were not directed to be cancelled, and remain withdrawn and pending.

Claims 1 and 2 as amended herein include the features that the support is locatable "on the non-cutting edge" of the blade to reduce flexing of the blade in use "when cutting into an article," and that the support is attachable "by pivot means."

In the April 9, 2008 Office Action rejecting claims 1-4, 10-15 and 18-24 as anticipated by Synbad US Patent 2,756,790, the Office has contended that the guard in Synbad is capable of being pivotably attached to the dull edge of a blade, and therefore Synbad's teaching reads on claims 1 and 2.

It first is pointed out that a hypothetical "capability" of being modified is NOT the criterion for either anticipation or obviousness of an invention – for anticipation to be present, all of the features of the invention must be identically present in the asserted reference, and for obviousness to be present, there must be a basis in the reference(s) or the knowledge in the art generally for the specific modification to be made. There is no "capability" test for patentability.

Synbad contains no suggestion that the guard can be located on the non-cutting edge of the blade. In fact, Synbad teaches the opposite of the applicant's claimed invention, by Synbad's teaching that the guard is located on the cutting edge of the blade. In the absence of a teaching of locating a support on the non-cutting edge of the blade, the applicant's claims cannot be anticipated by Synbad. In fact, the applicant's claimed invention will not work if a guard is attached to the cutting edge of the blade as disclosed in Synbad.

The support of the claimed invention and the guard of Synbad are located on the saw to perform different functions. The support in the applicant's claimed invention is employed to provide rigidity to the non-cutting edge of the blade when the saw is cutting an article, whereas the guard taught by Synbad merely covers the cutting edge of the blade, for protection when the saw is not in use. The differences between Synbad and applicant's claimed invention include the fact that Synbad's guard is designed to prevent cutting of an article, while the support of the applicant's claimed invention is provided to facilitate cutting.

Neither the saw nor the guard disclosed by Synbad comprises any pivot, nor does Synbad teach any use of the guard as a structural enhancement when the saw is being used for cutting an

article. The attachment means of the guard described by Synbad does not comprise any feature that allows the guard to attach to the blade via a pivot.

Synbad teaches structures that are similar to those shown in Figures 1 and 2 of the present application, which applicant has clearly identified as non-pivoting saw blade supports.

Synbad does not teach that the guard, which the Office considers to be equivalent to a support, has attachment means that allow the guard to be attached to the saw by pivot means. The guard disclosed by Synbad comprises an elongate body having a pair of straight walls, and the attachment to the blade is achieved by the elasticity of the blade-contacting portions of the guard. One of the objects of Synbad is to provide a guard that can be applied to different saws without the requirement of a special connection between the guard and the blade. The applicant's claimed invention, by contrast, requires that there be a pivot means for pivotable attachment of the support to the saw. Synbad fails to provide any derivative basis for such pivot means or pivotable attachment, and therefore cannot anticipate applicant's claimed invention.

Based on the foregoing, claims 1 and 2 are fully patentably distinguished from the disclosure of Synbad. Claims 3, 4, 10-15 and 18-24 are either directly or indirectly dependent from claim 1 or claim 2, and are therefore likewise patentably demarcated over Synbad.

It accordingly is requested that the rejection of claims 1-4, 10-15, and 18-24 be withdrawn, and that amended claims 16 and 17 be rejoined with claims 1-4, 10-15 and 18-24, incident to allowance of claims 1-4 and 10-24.

CONCLUSION

The examiner is requested to favorably consider the foregoing, and to responsively issue a Notice of Allowance. If any issues require further resolution, the examiner is requested to contact the undersigned attorney at (919) 419-9350 to discuss same, so that the prosecution of this application may be expeditiously concluded.

Respectfully submitted,

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